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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,031	09/12/2003	John A. Moon	CV-0039A	6760

7590 06/01/2006

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EXAMINER

LAVARIAS, ARNEL C

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,031

Applicant(s)

MOON ET AL.

Examiner

Arnel C. Lavarias

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-93,95-153 and 155-157 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-93,95-142 and 146 is/are rejected.
- 7) ☒ Claim(s) 143-145,147-153 and 155-157 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The cancellation of Claim 154 in the submission dated 4/3/06 is acknowledged and accepted.
2. The amendments to Claim 156 in the submission dated 4/3/06 are acknowledged and accepted. In view of these amendments, the objections to the claims in Section 9 of the Office Action dated 1/30/06 are respectfully withdrawn.

Response to Arguments

3. The claims of the instant application were provisionally rejected only under obviousness-type double patenting to corresponding claims in Application Nos. 10/661254, 10/661082, and 10/763995. Currently, Application No. 10/661082 has been indicated as allowed and will be passed to issue in due course. Further, it is noted that no terminal disclaimers were submitted along with Applicants' response filed 4/3/06. Thus, the obviousness-type double patenting rejections in Sections 11-13 of the Office Action dated 1/30/06 have not been withdrawn.
4. Claims 20-93, 95-142, 146 are now rejected as follows.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-

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type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 20-31, 40-41, 46-51, 53-69, 78-79, 84-89, 91-93, 95-135 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 21-45 of copending Application No. 10/661254. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/661254 similarly recites an optical identification element, encoded particle, and associated methods for reading an optical identification element and encoded particle, as set forth in Claims 20-31, 40-41, 46-51, 53-69, 78-79, 84-89, 91-93, 95-135 of the instant application. Further, it is noted that 1) 'a synthesized chemical' (See for example Claim 21 of copending Application No. 10/661254) is a subset of the generically recited 'chemical' of the instant application, 2) it would have been readily apparent and obvious to one having ordinary skill in the art for the surface of a particle to function in the same way as a substrate, and 3) it would have been readily apparent and obvious to one having ordinary skill in the art to perform the methods of

reading the encoded optical identification element and encoded particle based on the recited structure provided for the optical identification element and encoded particle.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 20-56, 58-93, 96-98, 114, 116-118, 134 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 24-60, 71-74 of copending Application No. 10/661082. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/661082 similarly recites an optical identification element, encoded particle, and associated methods for reading an optical identification element and encoded particle, as set forth in Claims 20-56, 58-93, 96-98, 114, 116-118, 134 of the instant application. Further, it is noted that 1) the recited 'item' (See for example Claim 24 of copending Application No. 10/661082) generally corresponds to the chemical as recited in the instant application, and 2) it would have been readily apparent and obvious to one having ordinary skill in the art that in attaching the chemical to at least a portion of the substrate, one may view either the chemical being disposed on the substrate, or conversely the substrate being disposed on the chemical.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 20-25, 27, 37-38, 46, 58-63, 65, 75-76, 84, 96-102, 106, 116-121, 126, 136-142, 146 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 20-44 of copending Application No.

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10/763995. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending application 10/763995 similarly recites an optical identification element having a chemical attached thereto, as set forth in Claims 20-25, 27, 37-38, 46, 58-63, 65, 75-76, 84, 96-102, 106, 116-121, 126, 136-142, 146 of the instant application. Further, it is noted that 1) the recited sample which is hybridized with the microbeads (See for example Claims 20, 22 of copending Application No. 10/763995) generally corresponds to the chemical attached to at least a portion of the substrate as recited in the instant application, and 2) it would have been readily apparent and obvious to one having ordinary skill in the art to perform the methods of reading the encoded optical identification element and encoded particle and performing a multiplexed particle assay based on the recited structure provided for the optical identification element and encoded particle.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 20-25, 27, 37-38, 41, 46, 56-63, 65, 75-76, 79, 84, 95-102, 106, 114-121, 126, 134-135 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-72 of copending Application No. 11/206987 (U.S. Patent Application Publication US 2006/0057729 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 11/206987 similarly recites an optical identification element, encoded particle, and associated methods for reading an optical identification element and encoded particle, as set forth in Claims 20-25, 27, 37-38, 41, 46, 56-63, 65,

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75-76, 79, 84, 95-102, 106, 114-121, 126, 134-135 of the instant application. Further, it is noted that 1) 'a substance' (See for example Claims 1-2, 18, 22 of copending Application No. 11/206987) generally corresponds to the chemical attached to at least a portion of the substrate as recited in the instant application, and 2) it would have been readily apparent and obvious to one having ordinary skill in the art to perform the methods of reading the encoded optical identification element and encoded particle based on the recited structure provided for the optical identification element and encoded particle.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

10. Claims 143-145, 147-153, 155-157 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 9:30 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arnel C. Lavarias
Patent Examiner
Group Art Unit 2872
5/25/06